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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,565	01/23/2004	Philippe Gambier	68.0418	4887

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EXAMINER

COLLINS, GIOVANNA M

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,565

Applicant(s)

GAMBIER, PHILIPPE

Examiner

Giovanna M. Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not recite an elastic substrate as recited in claims 19 and 20.

Claim Objections

3. Claim 16 is objected to because of the following informalities:

Claim 16 recites the limitation "the support layer" in line 2. There is insufficient antecedent basis for this limitation in the claim as this limitation has not been previously recited.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5,8-10,18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurlenya 2002/0127831.

Referring to claims 1-3, 5 and 8-10, Kurlenya discloses (see Fig. 15) a seal element comprising an energizing element (19) made of a composite metallic material (paragraph 0011) that is a cage substrate having parallel slotted members, an elastomeric sealing layer (15) covering a portion of the energizing element in which the energizing element uses potential energy to maintain contact between the sealing element and the wall of a wellbore or a pipe.

Referring to claim 18, Kurlenya discloses (figs. 14-15) placing a packer (4) having an energized seal element (at 19, 15) in the wellbore, setting the packer by actuating the seal element to form a seal between the packer and a wall surrounding the packer and maintain the seal using potential energy stored in the energized seal element (paragraph 0120).

6. Claims 1-3,6,8-9, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogen et al. 4,515,213.

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Referring to claims 1-5 and 8-9, Rogen discloses (see Fig. 1b)) a seal element comprising an energizing element (33) made of a composite metallic material (col. 7, lines 63-64) that is a spring, an elastomeric sealing layer (28) covering a portion of the energizing element in which the energizing element uses potential energy to maintain contact between the sealing element and the wall of a pipe.

Referring to claim 18, Kurlenya discloses (figs. 14-15) placing a packer (4) having an energized seal element (at 19, 15) in the wellbore, setting the packer by actuating the seal element to form a seal between the packer and a wall surrounding the packer and maintain the seal using potential energy stored in the energized seal element (paragraph 0120).

7. Claims 1-3, 8-9, 11-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Payton 4,424,865.

Referring to claims 1-3, 7-9, and 11-13, Payton discloses (see Fig. 1) a seal element comprising an energizing element (15) that composite metallic material, an elastomeric sealing layer (14) covering a portion of the energizing element in which the energizing element uses potential energy to maintain contact between the sealing element and the wall of a pipe, a metallic support sleeve (13) disposed around the energizing element that is embedded in the sealing layer.

Referring to claims 14-15 and 17, Payton discloses a energized seal element comprising an energizing element (15), a support sleeve at least partially enclosing the energizing element and a sealing layer that is thin layer of conformable material that at least partially enclosing the

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support sleeve, in which the energizing element uses potential energy to maintain contact between the sealing element and the wall of a pipe.

8.

9. Claims 1,4 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Coronado et al. 2002/0195244

Referring to claims 1,4 and 8-9, Coronado discloses (see Fig. 5) a seal element comprising an energizing element (46) that is a helically slotted tube, an elastomeric sealing layer (42) covering a portion of the energizing element in which the energizing element uses potential energy to maintain contact between the sealing element and the wall of a pipe.

10. Claims 1 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Loy et al. 3,070,167.

Referring to claims 1,7-9, Loy discloses (see Fig. 3) a seal element comprising an energizing element (58) that is a bow, an elastomeric sealing layer (60) covering a portion of the energizing element in which the energizing element uses potential energy to maintain contact between the sealing element and the wall of a pipe.

11. Claims 14-16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Arizmendi 5,941,313.

Referring to claims 14-16, Arizmendi (fig. 3) discloses a energized seal element comprising an energizing element (26), a support sleeve (22) at least partially enclosing the energizing element and a sealing layer (40) that is thin layer of conformable material that at least

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partially enclosing the support sleeve, in which the energizing element uses potential energy to maintain contact between the sealing element and the wall of a pipe and the energizing element when actuated deforms elastically into the support layer to produce a radially outward force on the sealing layer.

Referring to claim 21, Arizmendi discloses (fig. 9) a sealing apparatus comprising a tubing (10), and a plurality of energized sealing elements (at 40) in which the energizing element uses potential energy to maintain contact between the sealing element and the wall of a pipe.

12. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Oneal 6,123,148.

Referring to claim 18-20, Oneal discloses (figs. 1a-1b) placing a packer (10) having an energized seal element (at 54) in the wellbore, setting the packer by actuating the seal element to deform an elastic substrate by axially compressing the substrate to form a seal between the packer and a wall surrounding the packer and maintain the seal using potential energy stored in the energized seal element (paragraph 0120).

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent Application Publication 2004/0069504 to Krueger et al discloses a packer with an energized seal element.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 703-306-5707.

The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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